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EXAMINER

JANVIER, JEAN D

ART UNIT PAPER NUMBER

3622

DATE MAILED: 10/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/987,438

Applicant(s)

WIRTH, JOHN

Examiner

Jean Janvier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Response To Applicant's Amendments

The Examiner approves the new title of the invention, the abstract of the disclosure and the changes made to the claims.

Response To Applicant's Arguments

Although the Examiner disagrees with the Applicant's argument, filed on 08/01/2005, that dependent claims 20 and 34, which recited "...wherein the step of comparing said corresponding person's login name with said stored names further comprises allowing mis-keyed or mis-spelled entries in said stored names", disclose the restricted materials (see the most recent Examiner's Action), however, the Examiner finds the Applicant's arguments persuasive or plausible. Thus, the claimed invention as amended will be herein prosecuted on the merits.

Furthermore, the Applicant's new claim limitations are addressed in the present Office Action.

Additionally, the type of paper used to print the customer's name (login name and other addressing information) and the type of information displayed to a non-registered user or to a customer whose name or login name (P. I. Code) is not stored in a system database (displaying a welcome message to a user who mis-keys or mis-spells his login name or P. I. Code) is a matter of choice, desires or design specification, which does not directly impact the functionality of the system by which a mailer is transmitted to the customer or the customer is authenticated (validating the customer's login name or P. I. Code) before the customer can gain access to the system or the web site.

Therefore, the Applicant's request for allowance or withdrawal of the last Office Action has been fully considered and respectfully denied in view of the foregoing response or Action and thus, the current **Office Action has been made Final.**

DETAILED ACTION

Specification

Status of the claims

Claims 1-52 are now pending in the Instant Application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shane, US Patent 5, 793, 972 in view of Bezos, US Patent 6, 029, 141.

As per claims 1, 25, 39, 2-5, 8, 10-11, 16-24, 26-28, 32-38, 40 and 46-52, Shane discloses a system for providing an interactive response to direct mail programs comprises a recipient database, a mail generator, and a web server computer (first device) operationally connected through the Internet to remote computers (second devices) accessible by direct mail recipients or **screened users**. The recipient database stores data records containing addressing information such as the name, mail, fax or e-mail address, and a unique personal identification code or PIN number for each direct mail recipient (recipient database stores mailing list parameters). **The mail generator retrieves recipient data from the database and generates a multiplicity of direct mail pieces each displaying the name, address, and a uniform resource locator or URL containing the personal identification code for a screened or targeted recipient.** The targeted or responding recipient accesses the web server (first device) or central computer by entering the uniform resource locator or URL displayed on the received direct mail **piece or mailer (paper form)**, mailed via the post office or e-mailed to the targeted recipient, into a local web browser outputted on his remote computer or second device (logging step). The web server computer retrieves recipient data from the recipient database correlated to the personal identification code or PIN contained in the uniform resource locator and uses this recipient data to create a unique interactive web page, where the recipient or respondent views personal messages or ads directed to his attention.

Here, recipient database 12 stores recipient data records 22 containing recipient addressing information, such as the recipient's name and address and a unique personal identification code for each intended direct mail recipient. Typically the recipient data (mailing

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list) contained in the recipient data records 22 is obtained (by purchase or lease or rental) from a mailing list broker and entered or stored into the recipient database 12. The recipient database 12 may also include demographic and tracking information for each recipient (col. 3: 64 to col.4: 5).

Further, mail generator 14, typically located in a lettershop, is electronically coupled to recipient database 12 so as to be capable of retrieving the recipient data for each intended or targeted (via a screening or filtering process) direct mail recipient or user. Preferably, mail generator 14 of fig. 1 comprises a computer system 24 including a printer 25 for printing direct mail pieces 26 displaying thereon the name, address and uniform resource locator (or URL related to a web site) containing a unique personal identification code, for each intended recipient. Mail generator 14 also typically addresses and prepares direct mail pieces or mailers 26 for mailing through a postal system 28, which delivers mail pieces 26 to a plurality of locations 29, typically the home or office of each targeted or screened recipient (col. 4: 6-19).

In short, Shane discloses in fig. 4, the steps (of the method 100) carried out by apparatus 10. **An advertiser obtains one or more mailing lists from a list broker (by leasing or purchasing the mailing lists), wherein the mailing lists (raw data) are sent to a data house, along with any in-house lists and suppression lists that the advertiser has previously generated (Block 102). The data contained on the mailing and in-house lists are processed or filtered to eliminate duplicates and to prevent mail from being sent to certain individuals or addresses on the suppression lists, which the advertiser has previously determined would be inappropriate, to generate a recipient database 12 (screening the mailing lists to eliminate duplicate names or to prevent delivery to certain recipients' in a suppression list based at least on their addresses or locations, etc -Block 104). In a typical direct mailing,**

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the direct mail pieces 26 would then be printed by merging a pre-prepared form letter with data from the mailing lists, and the direct mail pieces or mailers 26 would be prepared for mailing and deposited with the post office 28 (col. 5: 63 to col. 6: 11).

In a preferred embodiment, the system also generates a respondent database containing the recipient data record for each responding recipient. The system also preferably is capable of detecting unauthorized attempts to generate personalized web pages by detecting an invalid personal identification code which does not match any of the personal identification codes stored in the recipient database (col. 4: 33-49).

See abstract; figs. 1-4; col. 2: 22 to col. 3: 32.

Shane supports, in general, the steps of printing users' names and addresses on mail pieces or mailers, containing advertising or promotions, and mailing the mail pieces to the users by a data house (processing mail pieces). The users may respond via phone calls or by ordering products featured in the mail pieces. Shane also discloses that the mailing lists can be rented or leased from a third party or broker (col. 1: 30-67).

Shane further discloses, with respect to a customer accessing the system web site, an access software 32 for basically determining whether or not the user's unique P. I. Code (or login name), printed on the user's mailer, is properly keyed in or spelled or formatted before the user is authenticated or authorized to access the web site to view promotional information subsequent to comparing the entered P. I. Code to a pre-recorded P. I. Code uniquely identifying the user. If the P. I. Code is mis-keyed or mis-spelled such that it does not match a pre-stored P. I. Code, then the system generates a web page indicating to the user that the entered P. I. Code (login name)

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could not be found (displaying a message or a welcome message to the user if the code or login name is mis-keyed- fig. 4D).

In general, the access software 32 accesses the unauthorized access attempts data 48 stored in the unauthorized access attempts database 46 to determine if an excessive amount of invalid personal identification codes (P. I. Codes or login names) have been submitted within a pre-determined period of time (Block 126). If this test is positive, then the web page creator 40 optionally generates and submits a new or previously stored web page to the web browser 34 of the customer's remote computer 20, which states that access to the personalized web page service is temporarily unavailable for the entered codes or login names (Block 128) (displaying a message or a welcome message for unmatched or mis-spelled login names or codes) The system then returns to the waiting stage of Block 116. If this test is negative, the web server computer 16 retrieves the Internet protocol address of the remote computer 20 requesting information (Block 130) (col. 6: 49-61).

See col. 6: 36 to col. 7: 49; figs. 4A-4D.

As per claims 1, 25 and 39, although, Shane supports, in general, the steps of printing users' names and addresses on mail pieces or mailers, containing advertising or promotions, and mailing the mail pieces to the users by a data house (processing mail pieces), wherein the users may respond via phone calls or by **ordering products** featured in the mail pieces, however, Shane does not expressly teach accessing by a user or customer or mail recipient a first device or web site associated with a mailer to place an order.

However, Bezos discloses an Internet-based referral service that enables a business or other entities or advertiser's associates to refer via a web site (web sites) customers, using a referral link displayed at the advertiser's associate web site 100, to a Merchant's or advertiser's web site 106 where they can receive more information regarding an advertised product/service or even purchase one or more products including the advertised product/service. The business or the advertiser's associate first registers with the referral service (providing an enrollment system) by setting up a referral link in his existing web site 100 which, upon actuation by a visiting customer viewing a product information, transports the customer to the Merchant web site 106 to receive more product information or purchase the associated product or other products. Subsequent to enrolling the advertiser's associate, an account or an ID or an identifier is created in real-time for the advertiser's associate or business (assigning an advertiser associate account identifier to uniquely identify the advertiser's associate) and this account is stored in a database related to the Merchant's or advertiser's web site 106 where it can be used to credit the advertiser's associate for each successful referral or when the customer buys the associated product featured in the product information displayed at the associate's web site. In addition, when the customer selects the referral link, the customer's computer 108 transmits unique IDs or identifiers of the selected product and of the advertiser's associate to the Merchant or advertiser web site 106, which allows the Merchant or advertiser to identify the advertised product and the referring advertiser's associate in an effort to properly compensate the referring advertiser's associate (using the assigned advertiser associate's account identifier) (See abstract; figs. 1-4; col. 7: 6-60). Further, Bezos explicitly shows in fig. 4 a URL 400 format used by the associate to create the referral

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link to the Merchant's or advertiser's web site 106, wherein the URL 400 comprises the Merchant's or advertiser's web server information (web site) 402, the unique product ID 404, the unique store ID or advertiser's associate web site identifier 406 for uniquely identifying the advertiser's associate web site 100 and the advertiser's associate commission scheme ID 408 and wherein the advertiser's associate commission ID 408 is used to optionally specify a commission percentage or a method for calculating the referral commission (col. 10: 39-67; col. 11: 1-26; figs 3-4).

In a preferred embodiment, the referral service system provides a software system and method for enabling an Internet merchant or advertiser to efficiently market and sell goods in cooperation with Web sites or other network sites of respective business partners, referred to herein as "associates." Through the merchant's site, an entity or individual or business can enroll (via an automated registration process) as an associate, and can then disseminate to visiting customers catalogs (Web documents, PUSH documents, e-mail newsletters, etc.) that include the associate's reviews and/or recommendations on specific products sold by the merchant (col. 1: 50-61). In other words, the product information or promotion or offer mailer (catalog documents), having printed therein the merchant's URL for facilitating the purchase of a product, can be distributed to targeted or visiting users via e-mail or delivery means (col. 1: 50-61). For example, the catalog documents 120 of fig. 1 served by the associate's site 100 include special hyperlinks (to Web pages of the merchant Web site 106) for allowing consumers to select products for prospective purchase. Typically, one such hyperlink is provided for each product displayed on the associate's Web site 100. Alternatively, a hyperlink may be provided for a group of products. When a customer selects (e.g., clicks on) the hyperlink associated with a particular

product, the customer is automatically connected to the merchant Web site 106 via the associate's web site, and presented with various options (included within Web pages 136 served from the merchant Web site 106) for allowing the customer to purchase the selected product from the merchant. The hyperlink thus serves as a referral mechanism for referring the customer to the merchant Web site 106 (col.7: 6-20).

Although the embodiment described herein uses Web technology to disseminate the catalog documents, any of a variety of document types and electronic dissemination technologies can be used. For example, the associate's catalog documents may be in the form of hyper-textual e-mail messages that are disseminated by a list server, or PUSH documents disseminated by a PUSH server. As interactive television, video-on-demand, and Web TV technologies continue to evolve, it is contemplated that the "catalog documents" will include video advertisements that are displayed to the customer on a television screen. Further, although hyper-textual catalog documents are preferably used, it is possible for an associate to use non-hyper-textual catalogs (including paper-based product catalogs including the associate's web site address) that simply instruct the customer to manually enter the appropriate URL (including the referral information or web site address of the merchant) into a local browser program (col. 8: 32-48).

Finally, providing or presenting to a user an advertising or promotional message, having printed thereon a URL or web site address where a product featured in the advertising message or other products can be purchased is well documented and well taught in the art.

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention to incorporate the Bezos' teachings into the system of Shane so as to enroll or register

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businesses or entities or individuals to become associates of at least one advertiser and to directly market products sold at the at least one advertiser's or merchant 's web site by distributing related product information or product offer or mailer or catalog documents, having printed therein the merchant's URL address or referral link, to targeted customers via an associate's web site (e-mail or regular mail delivery) when a customer or user or recipient visits the associate's web site and clicks on a referral link associated with a product offer and displayed thereon (or manually enters the merchant's URL into a local browser) to be transported to the at least one advertiser's or merchant's web site where the customer can receive more product information on a product advertised or featured in the displayed or mailed product offer or to simply purchase the advertised product or other products and wherein if the user or customer purchases the advertised product, then the referral service system extracts from the referral link the product ID and the associate's web site identifier (store ID) to uniquely identify and compensate the referring web site or the associate for a successful referral, thereby enabling the businesses or entities or individuals or associates to participate in the advertising referral service or system and become registered associates of the at least one advertiser and market products sold at the at least one advertiser's web site by disseminating related product information to targeted users or customers in exchange for a commission when a customer purchases at the advertiser's or merchant's web site a product advertised at the associate's web site and upon conclusively matching the associate's web site identifier (store ID) with a store ID extracted or read from the referral link, which was actuated by the referring customer, while providing more time to the advertiser to develop more business strategies since the distribution of the product offer is now

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handled by a plurality of independent associates working on behalf of the advertiser with minimal supervision or oversight since the system is performance based.

As per claims 6-7, 9, 29, and 41, although Shane discloses a recipient database (of the first device) storing recipients' demographic information, however, the combination of Shane and Bezos does not explicitly mention filtering or screening a mailing list, containing recipients' names, based on the users' or recipients' income, age (or demographic information) or purchase history.

However, providing targeted information to a user or filtering or screening content to be displayed to a user based on the user's demographic data or purchase history data is well documented or taught in the art (no further disclosure is necessary here). ("Official Notice")

Therefore, an ordinary skilled artisan, implementing the systems of Shane and Bezos, would have been motivated at the time of the invention to incorporate the above public disclosure or "Official Notice" into the system of Shane and Bezos so as to screen or filter the incoming mailing lists, containing users' names, in accordance with the users' or recipients' demographic profile (age, income, education, location, etc.) or purchase history profile matching the advertiser's target market and to store or record the result of the filtering process or the screened users' names in the recipient database for later retrieval and usage, thereby rendering the system more effective by processing or filtering the data (users' names) contained on the mailing and the advertiser's in-house lists to eliminate duplicates and to prevent mail or

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product information from being sent to certain individuals on the suppression lists (and incoming mailing lists), which the advertiser has previously determined would be inappropriate to receive a particular mailer or product information based on, for example, the users' location, income, age, gender, etc. (demographic parameters) or purchase history profile, before generating the recipient database 12 storing the screened or filtered names, while presenting targeted product offer to the filtered users' names, specifically directed to those users' attention.

As per claims 12-15, 30-31 and 42-45, although Shane teaches sending the information to a targeted user in paper form, the combination of Shane and Bezos does not explicitly mention providing the information to the user on a post card, chosen or made from high visibility or bright color paper stock that contrasts with the user's name and information printed thereon.

However, it is common practice to mail product information to a user via a flyer or other conventional form of mailer, chosen from white or color paper of high quality. Furthermore, printing the information on a post card, made from high visibility or bright color paper stock, as opposed to a flyer, made from a white or color premium paper is a matter of desires.

“Official Notice”

Therefore, an ordinary skilled artisan, implementing the systems of Shane and Bezos, would have been motivated at the time of the invention to incorporate the above public disclosure or “Official Notice” into the systems of Shane and Bezos so as to print the user's name, address, PIN and URL (CGI string) on a medium such as a flyer or post card made of high quality premium color paper, wherein the post card or flyer is subsequently mailed to the user,

thereby giving a professional look to the mailing piece or mailer, containing the information, while rendering it more attractive to the user, who is induced to read the enclosed information or content printed in the flyer or post card and uniquely directed to the user's interest or attention.

Conclusion

Although the following references were not used in the Office Action, they were highly considered by the Examiner. Applicants are further directed to consult these references.

US Patent 6, 567, 786B1 to Bibelnicks discloses a method, and system for increasing the efficiency of customer contact strategies is disclosed. Customers are analyzed based upon historical criteria; a promotional plan (a group of promotion events implemented or to be implemented over a particular time period) is analyzed to determine the effect of each promotion event on the other promotion events in the promotional plan; and, based on this analysis, the optimal promotion stream (a specific subset of the promotional plan to be sent to customers or a group of similar customers) is determined so as to maximize the ROI of the promotional plan as a whole.

US Patent 6, 076, 101 to Kamakura discloses an electronic mail processing system for distributing an e-mail message from a sender to recipients, which encourages the recipients to open, read, and reply to the e-mail message sent from the sender. An original e-mail message sent from a sender via a sender terminal is stored in an outgoing message storage unit. An outgoing mail information registration unit stores a list of recipients to whom the e-mail message

should be delivered, as well as storing information on bonus points. A message sending unit encloses bonus point information in the e-mail message and distributes it to the recipients included on the list. Upon receipt of a reply message from one of the recipients, a reception process unit gives a predetermined number of bonus points to the recipient. Each recipient's bonus points are accumulated in a recipient information storage unit, and he/she can redeem his/her bonus points for gifts depending on the accumulated points. This structural arrangement encourages the recipients to open the sender's message and write reply messages thereto in expectation of the redeemable bonus points, thus allowing the original message sender to collect more reply messages from the recipients than normally expected.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719.

Official Draft : 571-273-8300

10/25/05

JDJ

Jean D. Janvier

Patent Examiner

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**JEAN D. JANVIER
PRIMARY EXAMINER**

A handwritten signature in cursive script, appearing to read "Janvier Jean D", is written over the printed name and title.